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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/623,926	07/21/2003	Rudolf Maarten Bolle	YOR920000383US2	5377

7590 03/15/2006
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EXAMINER

WORLOH, JALATEE

ART UNIT PAPER NUMBER

3621

DATE MAILED: 03/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/623,926

Applicant(s)

BOLLE ET AL.

Examiner

Jalatee Worjloh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 9-17 is/are allowed.
- 6) ☒ Claim(s) 1-8 and 18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. In view of the Appeal Brief filed on December 15, 2005, PROSECUTION IS HEREBY REOPENED. New grounds for rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

2. Claims 1-18 have been examined.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting

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ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claim 1 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6836554 to Bolle et al. Although the conflicting claims are not identical, they are not patentably distinct from each other because Bolle et al. (6836554) disclose distorting in a processor a digital representation of one or more biometrics of a user to create a distorted biometric using one or more transformations, at least one of the transformations comprising one or more non-invertible function (i.e. a distortion process that selectably distorts the fist digital representation into a distorted digital representation by distorting at least one of the subcharacteristics, the distortion process being repeatable and non-invertible), comparing, in response to a transaction, the distorted biometric with one or more stored distorted biometrics, so that the distorted biometric represents a user without revealing the digital representation of the one or more biometrics (i.e. a comparison process that compares one or more sets of the distorted subcharacteristics to one or more stored sets of distorted subcharacteristics to determine the identity of the user).

5. Claims 2 - 4 rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 2 of U.S. Patent No. 6836554 to Bolle et al. Although the conflicting claims are not identical, they are not patentably distinct from each other because Bolle et al. (6836554) disclose the biometric is a physical characteristic (i.e. the characteristics include any one or more of the following: a fingerprint, a face a hand, an iris of an eye, a pattern of subdermal blood vessels, a spoken phrase, and a signature).

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6. Claims 5-8 depend on claim 1; therefore, these claims are also rejected.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1- 8 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent No. 6310966 to Dulude et al.

Referring to claim 1, Dulude et al. disclose distorting in a processor a digital representation of one or more biometrics of a user to create a distorted biometric using one or more transformations, at least one of the transformations comprising one or more non-invertible functions (see col. 10, lines 17-22 – hashing is a noninvertible; the transmitting section generates the transaction biometric data from the current set related to the physical condition of the user, generating a first hash value signal from the transaction first data and the transaction biometric data) and comparing, in response to a transaction, the distorted biometric with one or more stored distorted biometrics, so that the distorted biometric represents a user without revealing the digital representation of the one or more biometrics (see col. 10, lines 38-40 – generating a second hash value from the transaction biometric data and the transaction first data, comparing the first hash value to the second hash value).

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Referring to claims 2 -4, Dulude et al. disclose the biometric is a physical characteristic (i.e. fingerprint), behavioral characteristic (i.e. speech pattern) and the biometric includes any one or more of the following: one or more fingerprints, one or more minutiae, a voice pattern, a facial image, an iris, a hand signature, a auditory signature, a gesture, and a gait (see claim 1 above and col. 4, lines 25-31).

Referring to claim 5, Dulude et al. disclose the transaction is for one or more of the following: use of a financial instrument, providing a service, executing a contract, a sale, a bid, a submitted account number, an authorization, an identification, a reservation request, a purchase, a quote, an access to physical structure, an access to a financial account, an authority to manipulate a financial account, an access to a database, an access to information, a request for a privilege, a request for a network service, an offer for a network service, an auction, and an enrollment (see col. 5, lines 41-44).

Referring to claim 6, Dulude et al. disclose the distorted biometric is used to authenticate the user (see col. 10, lines 27-40).

Referring to claim 7, Dulude et al. disclose the user is any one or more of the following: a customer, a customer submitting an order on a network, a client, an employee, a user of a service, and a purchaser of a product (see col. 3, lines 31-34).

Referring to claim 8, Dulude et al. disclose the method being performed by any one or more of the following: the user, a company, a service company, a company selling products, a bank, a computer (i.e. kiosk or terminal), and a credit card company (see col. 5, lines 45-49).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dulude et al.

Dulude et al. disclose sending a transaction request and distorted biometric determined in a processor using one or more transformations that transform a digital representation of one or more biometrics of a user to the distorted biometric, at least one of the transformations comprising at least one non-invertible function and receiving an authorization for a transaction defined by the transaction request (see claim 1 above). Dulude et al. do not explicitly disclose sending a user identifier; however, the examiner notes a user biometric is also an identifier. Therefore, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Dulude to include a user identifier. One of ordinary skill in the art would have been motivated to do this because provides additional verification information thereby identifying unauthorized users.

Allowable Subject Matter

11. Claims 9-18 are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jalatee Worjloh whose telephone number is (571) 272-6714. The examiner can normally be reached on Mondays-Thursdays 8:30 - 7:00.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300 for Regular/After Final Actions and 571-273-6714 for Non-Official/Draft.

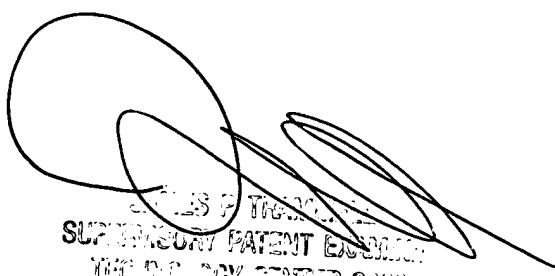
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Any response to this action should be mailed to:

***Commissioner of Patents and Trademarks
P.O. Box 1450
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Jalatee Worjloh
Patent Examiner
Art Unit 3621

March 2, 2006


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